Docket No.: PA-0035 US

CERTIFICATE OF TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the attention of Examiner Chakrabarti, Group Art Unit 1634, U.S. Patent and Trademark Office to Facsimile No. 703-305-3014 on February 10, 2003.

By: _____ Printed: Margaret M. Hasson

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Matthew R. Kaser

Title: GENES EXPRESSED IN TREATED HUMAN C3A LIVER CELL CULTURES

Serial No.: 09/919,039 Filing Date: July 30, 2001

Examiner: Chakrabarti, K. Group Art Unit: 1634

Box Non-Fee Amendment
Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. 121

Sir:

This paper is responsive to the Restriction Requirement and Request for Election dated January 10, 2003, setting a one (1) month term for response.

Restriction Requirement

In the Restriction Requirement, the Examiner requested Applicants to elect one of the following inventions:

Group I (claims 1-6 and 12-14) drawn to nucleic acids.

Group II (claims 7-11) drawn to a method of nucleic acid hybridization.

Group III (claims 15-16) drawn to a method of production of protein.

Group IV (claims 17-20) drawn to use of a protein.

Group V (claim 21) drawn to a protein.

The Examiner further stated that claims 1-11, 12-20 and 21 are generic to a plurality of disclosed patentably distinct species comprising 401 structurally and therefore patentably distinct species for claims 1-11, 18 structurally and therefore patentably distinct species for claims 12-20, and

3 structurally and therefore patentably distinct species for claim 21. Applicant is therefore required under 35 U.S.C. 121 to elect a single disclosed species for each appropriately elected group, even though this requirement be traversed.

Applicants hereby elect, with traverse, to prosecute Group I, which includes and is drawn to claims 1-6 and 12-14. Within this group, applicants further elect the nucleic acid species of SEQ ID NO:323 encoding the polypeptide of SEQ ID NO:324, again with traverse.

The Examiner is reminded that proper restriction requires the following two conditions be met according to MPEP 803:

Restriction-When Proper:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

> (A) The inventions must be independent (see MPEP Section 802.01 Section 806.04, Section 808.01) or distinct as claimed (see MPEP Section 806.05 - Section 806.05(i)); and
>
> (B) There must be a serious burden on the examiner if restriction is required (see MPEP Section 803.02 Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02). (Emphasis added.)

While patentable distinctiveness may have been established for some of the sequences recited the Examiner has clearly not established that there would be a serious burden of search in examining more than a single sequence in each of the elected groups. Applicants further submit that claims 7-11 of Group II and claim 15 of Group III are all methods of use of the polynucleotides of Group I that could be examined together with the composition of matter claims of Group I without undue burden. Applicants also point out that claim 16 of Group II and claim 21 of Group V are both drawn to a protein and should also be examined together.

Applicants therefore request reconsideration of the Restriction Requirement and examination of claims1-15 with respect to a reasonable number of species (i.e., at least five species). Applicants reserve the right to prosecute the subject matter of non-elected claims in subsequent divisional applications.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 09-0108.

Respectfully submitted,

INCYTE GENOMICS, INC.

Date: February 10, 2003

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